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10/820,095	04/08/2004	Koji Fujiwara	1248-0712PUS1	7125
225/2	7590	11/13/2008	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			SITTA, GRANT	
PO BOX 747			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No.	Applicant(s)
	10/820,095	FUJIWARA ET AL.
	Examiner GRANT D. SITTA	Art Unit 2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 July 2008.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-8 and 13 is/are allowed.
- 6) Claim(s) 9-12, 14 and 15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 08 April 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 7/03/2008 have been fully considered but they are not persuasive.
2. In regards to Applicant's argument that Russell is distinguishable from the present application because Russell discloses adjusting the pulse width based on the **current number** of receiver pulses instead of the **frequency of use** (Remarks, page 9 **claim 11**), Examiner respectfully disagrees. The pertinent part of claim 1 recites, "varying the infrared signal in response to a user input related to a frequency of use of pressure levels and in response to changes in pen pressure against the display." (last line of claim 11). The claim language requires the "varying" to be "related" to the "frequency of use" and to be in response to changes in the pen pressure against the display. The claim does not distinguish between past or present use. Thus, the teachings of Russell "current number" still read on the present claim limitations.
3. The rejection for **claim 12** is maintained for the same reason listed above.
4. In response to applicant's argument that Redford fails to input means in an order of frequency of use (Remarks, page 11 **claim 9**), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re*

Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In regards to the present application, Russell is being relied upon to teach a controller for controlling the infrared transmitter to produce a first signal when said first pressure level is detected and a second signal when said second pressure level is detected (fig. 5 col.6, lines 32-60).

Examiner notes that block 80 of fig. 5 uses a means to sort the pulses according to a threshold limit.

Russell fails to teach wherein said controller having a sequence input mode enabling inputs of a series of levels in an order of frequency of use.

However, Redford teaches a controller having a sequence input mode enabling inputs of a series of levels in an order of frequency of use (fig. 5 (a), (b) and (c)). Examiner notes while Redford is related to an electronic hand device that determines orientation but, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. Redford is being relied to teach pulse width modulation of a square wave (col. 7, lines 3).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify Russell to include the use of PWM as taught by Redford in order to control infrared signals since PWM can be used to reduce the total amount of power delivered.

Furthermore, Applicant asserts that neither of these signals are reference signals (Remarks, page 11 8 from bottom). Examiner respectfully disagrees. Both signals are reference signals to each other. Fig. 5 shows a system that allows for two inputs (fig. 5 input 1 and input 2). The pulse width modulation scheme chosen depends on which group is determined to be true (fig. 5 (a), (b) and (c)). Therefore, if Input 1 is greater with reference to Input 2 than group (b) is chosen and the corresponding pulse width modulation scheme is outputted.

In response to Applicant's remarks regarding **claim 10** (Remarks, page 12), that there is no disclosure that is directed to varying the signal in a manner determined by a sequence input of the user (second to last paragraph page 12). Examiner respectfully disagrees, for the same reason pointed out in claim 9 above. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. Russell teaches a means to change the pulse related to a contract pressure (fig. 5 (72-82)) and Redford teaches a manner determined sequence input of the user (fig. 5 (a), (b), and (c))

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify Russell to include the use of sequence input means as taught by Redford in order to control infrared signals.

6. Finally in response to Applicant's contention that in the last paragraph on page 12 (Examiner claim 11 was intended to be referenced instead of claim 1) that there is no disclosure in Russell that is directed to varying the signal based on the sensed contact pressure in a manner determined by a sequence input of a user. Examiner respectfully disagrees. Russell states, "as noted above the pen 14 can transmit an IR signal to the base whose occurrence indicates the transmission of US energy (for synchronization), and whose pulse width is proportional to the pressure on the tip 34." (col. 6, lines 20-25). The sequence of input of the user comprises using the pen by applying pressure and not using the pen by not applying pressure both of which according to Russell will vary the IR signal.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 11-12, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Russell et al (6,703,570) hereinafter, Russell.

9. In regards to claim 11, Russell teaches a method of transmitting a signal from an input pen to a display device comprising the steps of:

providing a display device (fig. 1 (16), col. 4, lines 1-6) having an infrared receiver (fig. 1 (20)) and an ultrasonic receiver (col. 4, lines 1-12, "With particular regard to the base 16, at least two ultrasonic (US) receivers 18");

providing an input pen (fig. 1 (2) including an infrared transmitter (fig. 2 (56)) for transmitting an infrared signal (col. 5, lines 32-60), an ultrasonic transmitter (fig. 2 (48)) for transmitting an ultrasonic signal (col. 5, lines 32-60),, and a pen pressure sensor sensing (col. 5, lines 32-60) pen pressure against the display (fig. 1 (16), col. 4, lines 1-6) and producing a pressure signal (col. 5, lines 32-60) related to pen pressure against the display (fig. 1 (16), col. 4, lines 1-6);

transmitting an infrared signal (col. 5, lines 32-60, "IR pulse") and an ultrasonic signal when the input pen contacts the display (fig. 4 (64), (66), and (68);

determining a location of pen contact (fig. 4 (62 and 68)) on the display from the infrared signal (fig. 4, (64) "IR pulse") and the ultrasonic signals (fig. 4 (64), "US signal); and

varying the infrared signal in response to a user input related to a frequency of use of pressure levels and in response to changes in pen pressure against the display (fig. 5, col. 5 40-67). Examiner notes the IR from the base are varied in response to the contact pressure.

10. In regards to claim 12, Russell teaches (Previously presented) The method of claim 11 wherein said step of varying the infrared signal in response to changes in pen

pressure against the display comprises the step of varying a pulse width of the infrared signal (col. 2, lines 50-60).

11. In regards to claim 14, Russell teaches (Previously presented) the method of claim 11 wherein said step of varying the infrared signal in response to changes in pen pressure against the display comprises the step of varying an interval between two infrared pulses in response to changes in the pen pressure against the display (col. 2, lines 50-60). Examiner notes when the pulse width is varied so with the interval between the two pulse widths.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell et al. (6,703,570) hereinafter Russell, in view of Redford et al (5,459,489) hereinafter Redford.

15. In regards to claim 9, Russell teaches an infrared transmitter transmitting (fig. 2 (56)) an infrared signal (col.5, lines 32-60), for communicating with an infrared receiver (fig. 1 (20)) associated with a display device (col. 4, lines 1-11 "base" such as an "IBM Thinkpad®");

an ultrasonic transmitter (fig. 2 (48)) for communicating with an ultrasonic receiver (col. 4, lines 1-12, "With particular regard to the base 16, at least two ultrasonic (US) receivers 18") associated with a display device (col. 4, lines 1-11 "base" such as an "IBM Thinkpad®");

a pen pressure sensor (col. 5, lines "contact sensors can include, e.g. force sensing resistors or other force sensors") sensing pen pressure against a surface and producing (col. 5, lines 32-60) a first output in response (fig. 4 (62)) to a first sensed pressure level (fig. 4 (62) on or pressure) and a second output in response to a second sensed pressure level (fig. 4 (62) off or no pressure); and

a controller for controlling the infrared transmitter to produce a first signal (fig. 4 (62) on or pressure) when said first (col. 6, lines 5-40) pressure level is detected and a

second signal (fig. 4 (62) off or no pressure); when said second pressure level is detected (col. 6, lines 5-40),

Russell differs from the claimed invention in that Russell does not disclose said controller having a sequence input mode input means enabling inputs of a series of levels in an order of frequency of use

However, Redford teaches a system and method for said controller having a sequence input mode (Redford, fig. 5 (a), (b), and (c)) input means (fig.5 input 1 and input 2) enabling inputs of levels in an order of frequency of use. Examiner notes that with pulse width modulation (PWM), which is taught by Russell (Russell teaches vary the contact signal in proportion the pressure level), needs at least two input signals. At the very least one of the signals must be a reference signal or threshold signal. Redford shows a PWM in which the PWM is used and a sequence of the input means is accomplished by placing the inputs in the three groups either (a), (b) or (c). The three groups are ordered by frequency of use (a) input 1 = input, (b) input 1>2, and (c) input 1<input 2.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify Russell to include the use of PWM as taught by Redford in order to control infrared signals since PWM can be used to reduce the total amount of power delivered. Examiner notes the Office's position is not being changed but rewritten for purposes of clarification.

Therefore, Russell as modified by Redford teaches controller having a sequence input mode (Redford, fig. 5 (a), (b), and (c) Redford) enabling inputs of a series of pen

pressure levels (fig. 5 72-82 col. 2, lines 50-60 Russell) in an order of frequency of use (Redford, fig. 5 (a), (b), and (c) Redford).

16. In regards to claim 10, Russell teaches a display device (fig. 1 (16), col. 4, lines 1-6) comprises an infrared receiver (fig. 1 (20)) and at least two ultrasonic receivers (col. 4, lines 1-12, "With particular regard to the base 16, at least two ultrasonic (US) receivers 18"); and

the input pen comprises an infrared transmitter (fig. 2 (56)), an ultrasonic transmitter (fig. 2 (48)) and a pressure sensor (col. 5, lines "contact sensors can include, e.g. force sensing resistors or other force sensors") producing a signal related to a contact pressure (col. 5, lines 32-60) between the input pen (fig. 1 (2)) and the display device ((fig. 1 (16), col. 4, lines 1-6);

wherein the display device (fig. 1 (16), col. 4, lines 1-6) further includes a controller (fig. 1 (16), col. 3-4, lines 55-10) for determining a location (fig. 1 col. 4, lines 10-30) of the input pen (fig. 1 (2)) on the display device (fig. 1 (16), col. 4, lines 1-6) when the input pen contacts the display device based on infrared and ultrasonic signals received (fig. 4 and 5 col. 6, lines 5-10) by the display device from the input pen (fig. 1 (16) and (2)); and

wherein the infrared transmitter sends a signal (fig. 4 (62)) that varies (fig. 4 (64)) IR pulse varies whether there is contact or no contact) with the sensed contact pressure (fig. 4 (62)) between the input pen (fig. 1 (2)) and the display device (fig. 1 (16), col. 4, lines 1-6).

Russell differs from the claimed invention in that Russell does not disclose a manner determined by a sequence input means of a user.

However, Redford teaches a system and method for sequence input (Redford, fig. 5 (a), (b), and (c)) input means (fig.5 input 1 and input 2) of a user (fig. 4 (62)) Examiner notes the sequence is determined whether the user makes contact with the pen tip.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify Russell to include the use of sequence input means as taught by Redford in order to control infrared signals.

17. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russell, in view of Colgan et al (6,529,189) hereinafter, Colgan.

18. In regards to claim 15, Russell differs from the claimed invention in that Russell does not disclose the method of claim 11 wherein said step of varying the infrared signal in response to changes in pen pressure against the display comprises the step: **of varying the infrared signal to transmit bit data**

However, Colgan teaches a system wherein said step of varying the infrared signal in response to changes in pen pressure against the display comprises the step of varying the infrared signal to transmit bit data (fig. 3-6 col. 4, lines 24-67).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify Russell to include the use varying the infrared signal in response to

changes in pen pressure against the display as taught by Colgan in order to transmit information digitally and all the advantages that accompany sending information digitally such as less susceptible to noise or other interferences.

Allowable Subject Matter

19. The following is an examiner's statement of reasons for allowance: claims 1-8 and 13.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

20. The reason for allowance of claim 1 is the prior art of record fails to teach "the input pen further includes sequence input means enabling inputs of a series of pen pressure levels in an order of frequency of use; and the pen pressure information infrared transmission control means controls the infrared transmission means to change the infrared signal in accordance with frequency of use of individual pen pressure levels as sorted through the sequence input means. "

21. The reason for allowance of claim 3 is the prior art of record fails to teach "the input pen further includes sequence input means enabling inputs of a series of pen pressure levels as sorted by frequency of use; and the pen pressure information

infrared transmission control means controls the infrared transmission means to transmit the infrared signal with pulse widths which grow longer in descending sequence of frequency of use of individual pen pressure levels as sorted through the sequence input means."

22. The reason for the allowance of claim 13 is the prior art of record fails to teach "establishing a series of pen pressure levels; ordering the pen pressure levels based on frequency of use; and associating each of the pen pressure levels with an infrared signal pulse width such that a more frequently used pen pressure level has a shorter pulse width than a pulse width of a less frequently used pen pressure."

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GRANT D. SITTA whose telephone number is (571)270-1542. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on 571-272-3638. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sumati Lefkowitz/
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November 5, 2008